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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,271
Filing Date: January 02, 2004
Appellant(s): DOSMANN ET AL.

Peter Prommer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 9th, 2010 appealing from the Office action mailed March 5th, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-10, 24-29, 31, 32, and 34-43.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 24, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a format for optical analysis as recited in claim 1 with the *additional* limitations that the detection guide is disposed approximately parallel to the illumination light guide, and further wherein the format includes an illumination redirection facet between the illumination light guide and the read window, and a detection redirection facet in the light pathway between the read window and the detection guide, does not reasonably provide enablement for the optical format as currently recited in claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. First, Appellant's specification does not envision any optical format in which the detection guide is not disposed approximately parallel to the illumination light guide. Secondly, the illumination redirection facet 30 and detection redirection facet 38 are necessary for the format of claim 1, as Appellant's specification does not envision any optical format in which the light may be guided around without the provision of facets 30 and 38 (which correspond to the limitations of claims 2 and 3). Appellant's specification does not provide broad support to such a format which does not utilize these facets. The specification does not describe an optical fiber or other light-guiding media which is curved and positioned so as to guide the light around absent the facets. Appellant's disclosure is solely directed to the optical format in which the facets 30 and 38 are necessary for redirecting and guiding the light to the detection guide.

Similarly, with regards to **claims 25-29, 31, and 32**, the claims are rejected under 35 USC 112, 1st paragraph because the specification, while being enabling for a format for optical analysis as recited in claim 25 and 29 with the *additional* limitations that the read window is positioned perpendicular to the illumination light guide and the detection guide is positioned approximately parallel to the illumination light guide and including the illumination redirection facet (as discussed above w/ respect to cl. 1) and the detection redirection facet (as discussed above w/ respect to cl. 1), does not reasonably provide enablement for the optical format as currently recited in claim 25. As discussed above with respect to claim 1, Appellant's specification does not provide basis for the embodiment of claims 25 and 29.

Claims 34-41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a format for optical analysis that includes a read window disposed along the light pathway and perpendicular to the illumination light guide and a detection guide disposed along the light pathway and parallel to the illumination light guide, and further including the illumination redirection facet (as discussed above w/ respect to cl. 1) and detection redirection facet (as discussed above w/ respect to cl. 1), does not reasonably provide enablement for the optical form as currently recited in claim 34. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. As discussed above with respect to independent claims 1, 25, and 29, Appellant's specification only envisions optical

formats in which the read window is disposed along the light pathway and is perpendicular to the illumination light guide, and the detection guide is disposed along the light pathway and disposed approximately parallel to the illumination light guide, and further wherein a illumination redirection facet and detection redirection facet are utilized to redirect and guide the light from the input, across the read window, and back out the detection guide.

Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a light guide that has a square cross-section comprising four sides that define an outside perimeter, does not reasonably provide enablement for a polygonal cross-section comprising a plurality of sides that define an outside perimeter. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Appellant's drawings in figure 4 show a light guide 18 with a square cross-section that has four sides defining an outside perimeter thereof, but Appellant's specification does not provide basis for a light guide having any sort of polygonal cross-section comprising a plurality of sides that define the outside perimeter.

(10) Response to Argument

A. With regards to claims 1-10, 24-29, 31, 32, and 34-43 being rejected under 35 USC 112, 1st paragraph as not being enabled over the scope of the claims, Appellant argues that the Examiner is improperly requiring that additional features from the specification be added to the rejected claims.

Appellant sets forth that the MPEP states that the determination of a rejection based upon the scope of a claim relative to the scope of enablement involves two stages of inquiry, consisting of:

- (i) determining how broad the entire claim is with respect to the disclosure;
and
- (ii) determining if one of ordinary skill in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation.

Examiner argues that the claims as currently recited are far broader than what is enabled by the specification. Appellant's disclosure does not provide basis for one of ordinary skill in the art to make and/or use the currently claimed formats. Appellant's disclosure does not provide any teaching(s) which provide one of ordinary skill in the art to make/use the additional embodiments encompassed by the claim language of the above claims. Appellant's disclosure does not include teachings or suggestive disclosure which would lead one of ordinary skill in the art to be able to make and use the invention in the scope of current claims. Examiner asserts that Appellant's

specification is limited to the embodiment discussed above (including those elements listed within the rejection of the claims under 35 USC 112, 1st paragraph), and is not enabled for the various optical formats encompassed by the current claims.

i. Appellant argues that the Examiner ignores broadening language in the specification and relevant controlling law.

Appellant argues that Examiner has not suggested that the area of technology (optical analysis of fluids using a molded optical format) is particularly complex or unpredictable. Examiner argues that, as discussed above, Appellant's specification is devoid of any teachings or disclosure that would lead one of ordinary skill in the art to be able to make and use the invention over the entire scope of the current claims. Without any sort of an instructive disclosure with respect to the current scope of the claims, the degree of unpredictability is extremely high as one of ordinary skill in the art does not have basis or instructions so as to establish the claims in the current scope. Further, undue experimentation would be required as one of ordinary skill in the art, in reading Appellant's disclosure, would not be provided with disclosure or guidance as to how to make and use the invention in the current scope of the claims. Examiner additionally argues that Appellant has failed to show where in the disclosure one of ordinary skill in the art would be lead to make and use the invention in the current scope of the claims. Appellant's drawings and written description are limited to the embodiments discussed within the rejection of the claims under 35 USC 112, 1st

paragraph, as Appellant's disclosure does not provide any sort of teachings that would lead one of ordinary skill in the art to make and use the claims in their current scope.

Appellant further argues that Examiner ignores and/or simply disregards specification language stating that the claims are not to be limited to the particular forms disclosed in the specification, such as in paragraphs [0016] and [0029]. Therein, it is stated, "...However, it should be understood that the invention is not intended to be limited to the particular forms disclosed..." and, "...those skilled in the art will recognize that many changes may be made thereto without departing from the spirit and scope of the present invention..."

Examiner argues that it is not enough to give basis for the current scope of the claims by mere inclusion of concluding states that provide generic, broadening language. Examiner argues that while it may not be the intention of Appellant to be limited to the particular forms disclosed, Appellant has failed in their duty to disclose the invention within the current scope of the claims. Appellant has failed to provide one of ordinary skill in the art with a disclosure that would lend one to make and use and the invention in the current scope of the claims. Similarly, while Appellant sets forth that those skilled in the art will recognize that many changes may be made to the embodiments, Examiner argues that, as discussed above, those of ordinary skill in the art would not be able to recognize the invention in the current scope of the claims. Toward the Summary of the Invention, Examiner argues that such paragraphs merely present an overall summary of the invention and does not provide enabling disclosure to the current scope of the claims.

ii. Appellant argues that the Examiner's own statements regarding alternatives are suggestive of modifications that would be known to one of ordinary skill in the art.

Appellant argues that the Examiner asserts within the rejection of the claims that "...[t]he specification does not describe an optical fiber or other light-guiding media which is curved and positioned so as to guide light around absent the facets". Appellant thereby argues that Examiner's assertions provide a basis toward one of ordinary skill in the art being able to practice the claimed invention without an undue amount of experimentation.

Examiner argues that a theorized assertion that an optical fiber or other light-guiding means which is curved and positioned so as to guide light around absent the facets does not constitute disclosure that would lead one of ordinary skill in the art to make and use the invention in the current scope of the claims without undue experimentation. Examiner's statements include a theoretical usage of an optical fiber, and additionally, a generically-stated "other light-guiding media which is curved..." Such theoretical statements issued by the Examiner do not make up for Appellant's lack of a disclosure which specifically provides teachings that would lead one of ordinary skill in the art to be able to make and use the invention in the current scope of the claims. Appellant's disclosure must contain actual teachings that provide one of ordinary skill in the art to be guided to make and use the invention. Theoretical statements made by the Examiner do not provide basis for one of ordinary skill in the art to make and use the invention in the current scope of the claims.

iii. Appellant argues that the Examiner erroneously attempts to limit claims 34-41 to "four overillumination redirection facets".

Appellant argues that paragraph [0019] provides disclosure which recites that more or fewer redirection facets may be employed as required by specific optical formats.

Examiner asserts that in view of Applicant's arguments and a reading of paragraph [0019], the portion of claims 34-41 under 35 USC 112, 1st which required four overillumination redirection facets has been removed. Examiner asserts that paragraph [0019] describes that each of the overillumination redirection facets 22, 24, 26, and 28 provide to redirect light from a respective direction, depending upon the facets location. It is thereby said that one of ordinary skill in the art would recognize that more or fewer facets could be utilized depending on the directional portion of light that is desired to be redirected from the light input.

Examiner maintains that the other elements listed in the rejection of claims 34-41 under 35 USC 112, 1st paragraph are maintained as necessary in order to be commensurate in scope with Appellant's disclosure. This includes the additional elements of a read window disposed along the light pathway and perpendicular to the illumination light guide and a detection guide disposed along the light pathway and parallel to the illumination light guide, and further including the illumination redirection facet (as discussed above w/ respect to cl. 1) and detection redirection facet (as discussed above w/ respect to cl. 1). Examiner argues that Appellant's disclosure only

provides a description with respect to such an embodiment and Appellant's disclosure does not include teachings or other disclosure which would lead one of ordinary skill in the art to be able to make and use the invention in the current scope of the claims.

B. Appellant argues that the Examiner is improperly requiring claims 35 and 36 to be limited to one narrow embodiment disclosed in the specification.

i. Appellant argues that the Examiner improperly asserts that the drawings only show an illumination light guide having a square cross-section.

Appellant argues that the rejection is based on erroneous allegations that the specification does not provide basis for a light guide having any sort of polygonal cross-section comprising a plurality of sides that define an outside perimeter. Appellant argues that the illumination light guide 18 illustrated in figure 4 could be understood to have a square or a rectangular cross-section, or to have any cross-sectional shape including four sides.

Examiner argues that Appellant has only shown that the drawings provide basis for a four-sided polygon (whether it be square or rectangular), and the drawings do not provide basis for any sort of polygonal cross-section. Examiner further argues that figure 2 also shows a four-sided polygonal cross-section for light-guide 18. Additionally, Appellant's written disclosure fails to provide basis for the usage of any polygonal cross-section, and one of ordinary skill in the art would not be able to make and use the invention in the current scope of claims 35 and 36.

ii. Appellant argues that Examiner's own admissions support that claims 35 and 36 are properly enabled.

Examiner argues that while figure 4 shows a light guide having a four-sided polygonal cross-section, this individual showing of a four-sided polygonal cross-section does not provide basis for the claims in their current scope. As discussed above, Appellant's drawings do not show anything other than a four-sided cross-section, and Appellant's written disclosure does not provide any teaching or suggestion that would lead one of ordinary skill in the art to be able to make and use the invention with a light guide having any polygonal cross-section, as in the current scope of the claims.

C. Appellant argues that the specification filed supports the claimed invention.

Appellant argues that the Examiner has improperly objected to the specification on three grounds.

Examiner argues that the objection to the specification is not an appealable matter.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1773

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Neil Turk/
Patent Examiner, Art Unit 1773

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